



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Wilmoth, Richard C.

Serial No.: 10/751,359

Filed: January 05, 2004

Title: *Orientation Independent Compartment Pressure Relief Valve*

Examiner: Derek S. Boles
Art Unit: 3749
Confirmation No.: 2197

**NOTICE OF APPEAL/
PETITION FOR ONE-MONTH EXTENSION
UNDER 37 C.F.R. § 1.136**

Pursuant to 37 C.F.R. § 1.191, Applicant hereby submits this Notice of Appeal of the above Examiner's Final Rejection dated **January 12, 2006**. Applicant also hereby petitions the Office to grant a one-month extension of time to file this Notice of Appeal. A check in the amount of \$310 is enclosed to cover the fees set forth in 37 C.F.R. § 41.20(b)(1) and § 1.17(a)(1). If it is determined that additional money is necessary, the Commissioner is authorized to charge Deposit Account No. 50-0686.

SUMMARY OF THE GROUNDS OF APPEAL

As initial grounds of appeal, applicant sets forth the following.

1. The current application sets forth claims 1 through 17 of which claim 1 is the only independent claim. Presently, no claims have been indicated as allowed in view of the prior art. Claims 4, 8, 9, 12, 13, and 17 stand objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 1 through 3, 5 through 7, 11, 14, 15 stand collectively rejected under 35 U.S.C. § 103(a) as unpatentable over *Gies et al.* (U.S. Patent No. 5,355,910) in view of *Klomhaus et al.* (U.S. Patent No. 5,194,038). Claim 16 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *Gies et al.* in view of *Klomhaus et al.* and in further view of *Barton* (U.S. Pat. No.

6,210,266). Finally, Claim 10 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *Gies et al* in view of *Klomhaus et al*, and in further view of *Opperman et al* (U.S. 6,609,535).

2. Examiner has erred in rejecting Independent Claim 1 as obvious under § 103(a) over *Gies et al* in view of *Klomhaus et al*. Specifically, Examiner has not met the burden of establishing a prima facie case of obviousness as is required by law and by the Manual of Patent Examination Procedure (“MPEP”). To meet the burden of establishing a prima facie case, the Examiner must show

some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to . . . combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference[s] must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.

MPEP § 2142 8th Ed., Rev. 2 May, 2004 (citing *In re Vraek*, 947 F.2d 488 (Fed. Cir. 1991)).

3. The Examiner has not demonstrated by preponderance of the evidence that there is a suggestion or motivation, either expressed in the references or in the prior art, for the proposed combination. There can be no suggestion to combine where the proposed modification of a reference changes the principle of operation of a reference. *See* MPEP 2143.01, pp. 2100-132. *Gies et al* teaches a non-integrated flap valve that closes by gravity. Therefore, a living hinge formed solely of a pliable layer is required. *Klomhaus et al* teaches an integrated flap valve that is biased closed by virtue of the way the housing and flap are molded. Neither reference teaches or suggests the desirability for a non-integrated flap valve that closes irrespective of gravity. Nonetheless, the combination would “require a substantial reconstruction and redesign of the elements shown in [*Gies et al*] as well as a change in the basic principle under which the [*Gies et al*] construction was designed to operate.” *Id.* (quoting *In re Ratti*, 270 F.2d 810, 813 (Cir. Ct. Pat. App. 1959) (emphasis supplied)).

4. All of the claim limitations are not taught or suggested by the proposed combination as is required under MPEP § 2143.03. Moreover, the Examiner not sufficiently demonstrated how an integrated, one-layer flap valve (*Klomhaus et al*) may be combined with a two-layer, gravity-dependent flap valve (*Gies et al*) to achieve the invention recited in the claims. In justifying the combination, Examiner cites only the addition

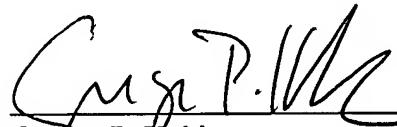
of the function of the *Klomhaus et al* valve, but does not indicate how the structure of *Klomhaus et al* may be combined with *Gies et al* to achieve the invention claimed.

5. Examiner used impermissible hindsight. "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczaik*, 175 F.3d 994, 50 U.S.P.Q2d 1614, 1617 (Fed. Cir. 1999). Examiner's statements in the Final Office Action indicate that the teachings of the present disclosure were used in making the determination that the proposed combination of references renders the claimed invention obvious. Further, because Examiner has not provided a suggestion to combine it is clear that hindsight was primarily the source of Examiner's conclusions.

Because the Examiner has not shown there is sufficient suggestion or motivation to combine the references, and since the proposed combination does not teach the invention to which the claims are drawn, the proposed combination, by law, cannot render the claimed invention obvious under 35 U.S.C. § 103(a), and the rejection is due to be withdrawn. Applicant contends, therefore, that the claims are in condition for allowance.

Respectfully submitted,

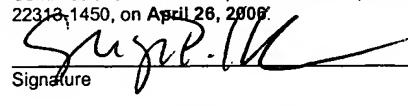
April 26, 2006


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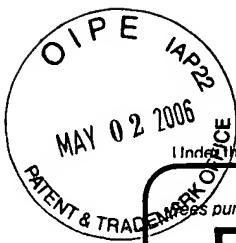
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Effective on 12/08/2004.

Pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL For FY 2005

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 310)

Complete if Known

Application Number	10/751,359
Filing Date	01/05/2004
First Named Inventor	Richard C. Wilmoth
Examiner Name	Derek S. Boles
Art Unit	3749
Attorney Docket No.	03-0898.01

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify): _____

Deposit Account Deposit Account Number: 50-0686 Deposit Account Name: Lanier Ford

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Small Entity	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	
				Fee (\$)	Fee (\$)
- 20 or HP =	x	=		50	25

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	
				Fee (\$)	Fee (\$)
- 3 or HP =	x	=			

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

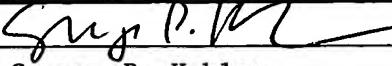
4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Notice of Appeal

250

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	46,837	Telephone	256-535-1100
Name (Print/Type)	George P. Kobler			Date	04/26/2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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